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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,215	12/28/2001	Gilles Garnier	217496US0CONT	2618

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n N .	Applicant(s)	
	10/028,215	GARNIER ET AL.	
	Examiner	Art Unit	
	Lawrence D Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Election

1. This action is in response to the provisional election, May 30, 2003. Group II (Claims 36-40) were provisionally elected with Group I (Claims 19-34) held to a non-elected invention. Upon further consideration the restriction requirement is withdrawn and claims 19-40 are pending.

Claim Rejections – 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36-40 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 36-40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a laminated window and film, does not reasonably provide enablement for a method of acoustically attenuating noises of structure-borne origin in an article of manufacture, which comprises installing therein the laminated window. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to acoustically attenuate noises of

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structure-borne origin in an article of manufacture of the invention commensurate in scope with these claims.

NONSTATUTORY DOUBLE PATENTING

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the applicant must fully comply with 37 CFR 3.73(b).

5. Claims 19-29 and 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,074,732. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both include a laminated window comprising a glass sheet and an intermediate film, wherein said film has a loss factor δ greater than 0.6 and a shear modulus G' in a temperature range between 10 and 60°C and in a frequency range between 50 and 10,000 Hz. They both include at least one

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film of normal acoustic performance and a window wherein the intermediate film comprises viscoelastic polymer made of acrylic polymer without plasticizer having a shear modulus G' between $10^{4.5}$ Pa at 60.degree. C. and $10^{6.5}$ Pa at 0°C. as well as a loss factor $\tan \delta$ between approximately 0.8 and 1 in a temperature range of 0 to 60°C. They both include a film designed to be used as an intermediate layer in a soundproofing laminated window, said film having a loss factor $\tan \delta$ greater than 0.6 and a shear modulus G' in a temperature range between 10 and 60.degree°C and in a frequency range between 50 and 10,000 Hz. They both include a film wherein said film comprises plasticizers and polyvinylacetal resins. Additionally, they both include a method of acoustically attenuating noises of structure-borne origin in an article of manufacture.

Claim Rejections – 35 USC § 103(a)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Alpen (U.S. 5,496,643).

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8. Von Alpen discloses glass panes with intermediate layers of thermoplastic polymer disposed between them with the interior surface mounted by means of thermoplastic adhesive film (abstract) which serves the same function as a cement film. Von Alpen discloses the invention has a radiation-reflecting layer (column 1, lines 50-53 and column 2, lines 9-10). Von Alpen discloses a laminated glass pane, which can be a window (column 3, lines 9-20). The reference discloses two glass sheets and a thermoplastic intermediate film with a thermal radiation-reflecting film (claim 5). Von Alpen does not disclose a loss factor, shear modulus G' or frequency. Because the reference uses the same materials as applicant, it would have been obvious that the loss factor, shear modulus G' and frequency, would occur at the claimed levels absent any evidence to the contrary.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Termath (U.S. 5,506,037) discloses a heat reflecting laminated glazing system (abstract). Nakamachi et al. (U.S. 5,066,525) discloses a laminated glass panel (abstract). Kuster (U.S. 5,380,575) discloses a glass pane for automobiles comprising glass sheets and an intermediate layer (abstract).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson
Examiner
June 14, 2001

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

